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10/501,399	12/23/2004	Koji Okomori	47172	2492

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT PAPER NUMBER

1762

DATE MAILED: 10/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/501,399

Applicant(s)

OKOMORI ET AL.

Examiner

Katherine A. Bareford

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 08 September 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2,5-7 and 9-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

*Claims 1, 3-4 and 8 are canceled*

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

The amendment of August 29, 2006 and the supplemental amendment of September 8, 2006 have been received and entered. With the amendment, claims 1, 3-4 and 8 are canceled and claims 2, 5-7 and 9-14 (including new claims 13-14) are now pending for examination.

### *Claims*

1. As to the use of "a film transfer method" in the claims, the Examiner understands this to require a roll coating method as described at page 1 of the specification. As applicant has not disagreed with this statement from the March 29, 2006 Office Action, it is considered agreed to.

### *Claim Rejections - 35 USC § 112*

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 2, 5-7 and 9-14 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably

convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

(1) Independent claims 2 and 5 have been amended to require that "wherein cold set printing ink is not used for the offset or gravure printing" (claim 2) and "wherein cold set printing ink is not used for the offset printing" (claim 5). Moreover, new claim 13 provides "A method for offset printing or gravure printing with an offset printing or gravure printing ink that is not a cold set printing ink" and new claim 14 provides "A method for offset printing with a web offset printing ink that is not a cold set printing ink". These claimed features are all new matter. The disclosure as originally filed of the present case makes absolutely no mention of the non-use of "cold set printing inks". As discussed in MPEP 2173.05(i) as to negative limitations:

**"Any negative limitation or exclusionary proviso must have basis in the original disclosure.** If alternative elements are positively recited in the specification, they may be explicitly excluded in the claims. See *In re Johnson*, 558 F.2d 1008, 1019, 194 USPQ 187, 196 (CCPA 1977) ("[the] specification, having described the whole, necessarily described the part remaining."). See also *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed. Cir. 1984). **The mere absence of a positive recitation is not basis for an exclusion.** Any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement." (emphasis added).

Here applicant has provided no basis for specifically excluding "cold set printing inks" in the original disclosure and therefore the claimed negative limitation is new matter.

(2) in new claim 13, last line, applicant claims that the "coating weight per side is 1 g/m<sup>2</sup> or more". However, there is no support for this weight range in the disclosure

as originally filed. The disclosure as originally filed refers to a coating weight per side of 7 g/ m<sup>2</sup> or more, not 1 g/ m<sup>2</sup>. Therefore, the amendment contains new matter.

***Claim Rejections - 35 USC § 102***

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 2, 5-7 and 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Wurster et al (US 6197155).

Claim 2: Wurster teaches a method for producing coated paper for printing. Column 1, lines 3-5. A coating color containing a pigment and an adhesive (binder) is applied to a base paper. Column 2, lines 50-65 and column 3, lines 5-15. The coating color contains, for example, 1 wt % polyvinyl alcohol (PVA) in relation to coating pigment (1 part by weight PVA to 100 parts by weight of the pigment). Column 2, lines 60-65 and column 6, lines 43-45. The coating color application method can be film transfer methods such as the Massey coater (which is inherently a transfer roll coater method) or a metering size press. Column 4, lines 20-30. The coating weight can be 7 g/m<sup>2</sup>. column 4, lines 40-45. The coated paper can be used for offset printing. Column 1, lines 3-5.

While Wurster teaches that the coated paper is suitable for use with a cold set offset printing ink, in the claim applicant has not provided any actual recitation of offset printing without using cold set printing ink, as the claim is directed to "A method for producing coated paper" and no positive actual recitation of performing any offset or gravure printing is provided. Therefore, the claim only provides for the "intended use" of the produced paper made by the claimed process. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, since the claimed produced paper has the same materials applied and the same method of application as Wurster, it has the same resulting structure.

Claim 5: Wurster teaches a process as described in claim 2. The coated paper is for offset printing. Column 1, lines 3-5. The polyvinyl alcohol can be in addition to other adhesive, and thus serves as an auxiliary to the extent claimed. Column 2, lines 55-68 and column 3, lines 20-40. The amount of starch present can be 0 percent, thus providing less than 2.0 parts by weight of starch as an adhesive. Column 3, lines 30-40. The coating color application method can be film transfer methods such as the Massey coater (which is inherently a transfer roll coater method) or a metering size press. Column 4, lines 20-30. As to the claim that "cold set printing ink is not used for the offset printing" as discussed with regard to claim 2 above, while Wurster teaches that

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the coated paper is suitable for use with a cold set offset printing ink, in the claim applicant has not provided any actual recitation of offset printing without using cold set printing ink, as the claim is directed to "A method for producing coated paper" and no positive actual recitation of performing any offset printing is provided. Therefore, the claim only provides for the "intended use" of the produced paper made by the claimed process. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, since the claimed produced paper has the same materials applied and the same method of application as Wurster, it has the same resulting structure.

Claim 6: the coating color can be 18 weight percent adhesive (binder) in relation to coating pigment (18 parts by weight of adhesive based on 100 parts by weight of the pigment) or less. Column 3, lines 10-25.

Claim 7: the coating color can be 20 g/ m<sup>2</sup> total weight, on both sides, with the coating mass spread roughly uniformly on both coat applications, thus providing roughly 10 g/ m<sup>2</sup> on each side of the base paper, which is more than 7 g/ m<sup>2</sup> on each side. Column 4, lines 45-55.

Claim 9: a coated paper for printing is produced by the method according to claim 5. Column 1, lines 3-5.

Claims 10 and 11: the coating color can be 18 weight percent adhesive (binder) in relation to coating pigment (18 parts by weight of adhesive based on 100 parts by weight of the pigment). Column 3, lines 10-25.

Claim 12: the coating color can be 65 weight percent solids, for example. Column 4, lines 20-25.

Claim 13: Wurster teaches a method for producing coated paper for printing. Column 1, lines 3-5. A coating color containing a pigment and an adhesive (binder) is applied to a base paper. Column 2, lines 50-65 and column 3, lines 5-15. The coating color contains, for example, 1 wt % polyvinyl alcohol (PVA) in relation to coating pigment (1 part by weight PVA to 100 parts by weight of the pigment). Column 2, lines 60-65 and column 6, lines 43-45. The coating color application method can be film transfer methods such as the Massey coater (which is inherently a transfer roll coater method) or a metering size press. Column 4, lines 20-30. The coating weight can be 7 g/m<sup>2</sup>. Column 4, lines 40-45. The coated paper can be used for offset printing. Column 1, lines 3-5.

Although Wurster teaches that the coated paper is suitable for use with a cold set offset printing ink, in the present claim applicant has not provided any actual recitation of offset or gravure printing without using cold set printing ink. While the claim is directed to "A method for offset printing or gravure printing" no positive actual recitation of performing any offset or gravure printing is provided. Therefore, the claim only provides for the "intended use" of the produced paper made by the claimed



process, as the only positively recited steps refer to making the paper. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, since the claimed produced paper has the same materials applied and the same method of application as Wurster, it has the same resulting structure.

Claim 14: Wurster teaches a process as described in claim 13. The coated paper is for offset printing. Column 1, lines 3-5. The polyvinyl alcohol can be in addition to other adhesive, and thus serves as an auxiliary to the extent claimed. Column 2, lines 55-68 and column 3, lines 20-40. The amount of starch present can be 0 percent, thus providing less than 2.0 parts by weight of starch as an adhesive. Column 3, lines 30-40. The coating color application method can be film transfer methods such as the Massey coater (which is inherently a transfer roll coater method) or a metering size press. Column 4, lines 20-30. As to the claim that the method is for "web offset printing with a web offset printing ink that is not a cold set printing ink", as discussed with regard to claim 13 above, although Wurster teaches that the coated paper is suitable for use with a cold set offset printing ink, in the present claim applicant has not provided any actual recitation of offset printing without using cold set printing ink. While the claim is directed to "A method for offset printing" no positive actual recitation of performing any offset printing is provided. Therefore, the claim only provides for the "intended

use” of the produced paper made by the claimed process. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Here, since the claimed produced paper has the same materials applied and the same method of application as Wurster, it has the same resulting structure.

*Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 2, 5-7 and 9-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Saji et al (US 5030325) in view of Hershey et al (US 4154899).

Saji teaches a method of producing coated paper for printing. Column 2, lines 15-30 and column 1, lines 10-20. A coating color containing a pigment and an adhesive is applied on a base paper. Column 2, lines 15-30. The coating color can contain polyvinyl alcohol and starch as adhesives. Column 4, lines 10-30. The adhesive can be 5-50 wt parts per 100 wt parts pigment, preferably 10-30 wt parts adhesive per 100 wt

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parts pigment. Column 4, lines 25-35. The applied coating weight can be 50 g/m<sup>2</sup>.

Column 4, lines 60-65. The coating can be applied to the paper by various methods, such as blade coating, a roll coater, a reverse roll coater, a gravure coater, a size press coater etc. Column 4, lines 40-48. A coated paper is provided for printing. Column 2, lines 15-30 and column 1, lines 10-20. The coating color can be 40-75 wt% solids.

Column 4, lines 45-55.

Saji teaches all the features of these claims except (1) the precise amounts of polyvinyl alcohol (claim 2), (2) the offset printing, (3) the amount of starch (claim 5), (4) the transfer roll coater method (claim <sup>5,14</sup>~~8~~).

Hershey teaches a method for producing coated paper for printing. Column 2, lines 15-30. A coating color containing a pigment and an adhesive is applied on a base paper. Column 2, lines 30-40. The coating color can contain 5-30 parts adhesive per 100 parts pigment. Column 5, lines 10-15. The coating color can contain 1.5 parts by weight of polyvinyl alcohol per 100 parts by weight of the pigment as part of the overall weight of adhesives. Column 12, lines 5-10 and 30-55 (Example 8). The PVA would be an auxiliary to other adhesives provided, as it is not the sole adhesive. Column 12, lines 30-55. The applied coating weight can be 12 lbs/ream (> 7 g/m<sup>2</sup>) (for example 10 lbs/ream is approx. 14.6 g/m<sup>2</sup>). Column 3, lines 10-15. Hershey teaches to apply the coating by blade coating. Column 2, lines 15-25. The paper can be for offset printing. Column 2, lines 25-30. Hershey teaches that the paper was printed on using offset printing methods. Column 9, lines 5-20. The coating can also be 1.5 parts by weight of

starch as an adhesive per 100 parts by weight of the pigment. Column 12, lines 5-10 and 30-55 (Example 8). The amount of adhesive can be less than 18 parts by weight per 100 parts by weight of the pigment (note Example 8, which has 15 parts by weight). Column 12, lines 5-10 and 30-55 (Example 8). A coated paper is produced. Column 2, lines 15-30.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Saji to use the paper for offset printing and to use the starch and polyvinyl alcohol amounts suggested by Hershey in order to provide a desirable paper for a process such as offset printing, because Saji teaches that a desirable paper for printing is coated with pigments and adhesives that can include starch and polyvinyl alcohol, and Hershey teaches that desirable papers for printing made by coating with pigments and adhesives can be used in offset printing and that desirable amounts of starch and polyvinyl alcohol are 1.5 wt parts per 100 weight parts of pigment for each. It further would have been obvious to modify Saji in view of Hershey to use a transfer roll coater as the film transfer method with an expectation of achieving a desirable coating, as Saji teaches that a variety of roll coating (film transfer) methods can be used, and it is the Examiner's position that transfer roll coating is a well known method of roll coating. It further would have been obvious to modify Saji in view of Hershey to offset print using a printing ink that is not a cold set printing ink with an expectation of desirable coating results, because Saji in view of Hershey teaches making a paper for use in offset printing processes, with no limitation on the coating

materials to be used, and therefore, one of ordinary skill in the art would expect desirable results from all offset printing, which would include heat set or cold set ink.

8. Braaten, et al "Changing Sheet Characteristics Drive Move to Film Coating", Pulp & Paper Magazine, May 1, 1996, indicates the definition of a Massey Coater as a transfer roll coating system. Clancy et al (US 3157533) also indicates the definition of a Massey Coater as a transfer roll coating system (column 13, lines 5-15).

#### *Response to Arguments*

9. Applicant's arguments filed August 29, 2006 and September 8, 2006 have been fully considered but they are not persuasive.

(1) As to the arguments provided as to the use of Wurster, the Examiner has reviewed these arguments, however, the rejection is maintained. As to the exclusion of "cold set printing ink" from the "offset or gravure printing" process, as discussed in the rejection above, this is directed to intended use of the paper material formed by the claimed process, and a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. As discussed fully in the rejection above, the formed paper meets all the structural requirements of the present claims and thus does not patentably distinguish the

claimed invention from the prior art. As to the argument that Wurster fails to disclose the claimed method by not applying the coating color containing a pigment, an adhesive and a polyvinyl alcohol in the amounts of claim 2 or the claimed method of applying a coating color containing a pigment, polyvinyl alcohol and a starch as in claim 5, the Examiner disagrees. In the rejection above, the Examiner has pointed to exactly where in Wurster the claimed pigment, adhesive and polyvinyl alcohol in the claimed amounts of claim 2 are provided, and the Examiner has further pointed out where all the required features of claim 5 are provided in Wurster. Applicant has provided no arguments and pointed to no part of Wurster as to what is not actually provided. Therefore, applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

As to the arguments provided as to the combination of Saji in view of Hershey, the Examiner has reviewed these arguments, and remains of the position that Saji in view of Hershey provides the features of the invention as claimed. As previously discussed in the last Office Action, as to the argument that while Saji provides PVA as a conventional adhesive, it does not provide it as an addition to improve transferability to enable a coating weight of 7 g/m<sup>2</sup> or more, and that Hershey, while indicating that the coating can contain 1.5 parts by weight PVA, teaches blade coating and does not suggest the claimed film transfer method, the Examiner disagrees. Saji provides that for

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paper coating for printing using adhesives/pigment, the adhesives can include PVA and other materials and that blade or roll coating methods can be used (column 4, lines 10-30 and 40-50). Hershey provides that for paper coating for printing using adhesives/pigment the adhesives can include PVA and other materials and the amount of PVA can be 1.5 parts by weight and that the coating method is blade coating. It would have been obvious to one of ordinary skill in the art to use the adhesive amounts, including the PVA of 1.5 parts by weight, of Hershey when performing the coating process of Saji with an expectation of desirable coating results, because Saji teaches adhesive materials overlapping with Hershey and coating methods overlapping with Hershey, and Hershey teaches specific amounts of the adhesive materials that provide a desirable coating. Saji provides that blade coating and roll coating are both desirable methods to use with the adhesive/pigment coatings. Saji and Hershey both provide that the claimed coating weight can be achieved. As to the argument as to the improved transferability, the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). As to the dependent claims, all of the features of these dependent claims are provided by the combination of the references as discussed above.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (571) 272-1413. The examiner can normally be reached on M-F(6:00-3:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Timothy Meeks can be reached on (571) 272-1423. The fax phone numbers for the organization where this application or proceeding is assigned are (571) 273-8300 for regular communications and for After Final communications.


Other inquiries can be directed to the Tech Center 1700 telephone number at (571) 272-1700.

Furthermore, information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information



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for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
KATHERINE BAREFORD  
PRIMARY EXAMINER